



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,372	01/03/2002	Akimoto Masao	P21380	8656
7055 7590 05/02/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER JOO, JOSHUA	
			ART UNIT 2154	PAPER NUMBER
			NOTIFICATION DATE 05/02/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

**Office Action Summary**

Application No.

10/034,372

Applicant(s)

MASAO ET AL.

Examiner

Joshua Joo

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

**Response to Amendment filed 2/28/07**

1. Claims 7-13 are presented for examination.

**Response to Arguments**

2. Applicant's arguments with respect to claims 7-13 have been considered but are moot in view of the new ground(s) of rejection. Applicant argued that:
  3. (1) Chen fails to disclose a controller than transmits HTML data to the recipient, based on URL data, as taught by the present invention. Chen utilizes a command to request the e-mail message from the e-mail system, but the HTML converter facility 158 does not utilize URL data to transmit the e-mail message to the e-mail recipient.
  4. In response, Chen has been withdrawn from the instant Office action. However, Examiner respectfully notes that the claims are not limited such that a request cannot be sent for converted e-mail messages.
  5. (2) Beer does not disclose a controller which receives, from an Internet facsimile apparatus via a second communicator, an e-mail address of a recipient according to a SMTP protocol. Rather, Beer et al. teaches that a user enters, by hand, an e-mail address into a Login Manager 3, which runs on a user system 5. The Login Manager 3 determines a URL corresponding to the e-mail.
  6. In response, the combination of Tada, a newly cited reference for this Office action, and Toyoda teach of receiving from an Internet facsimile apparatus via a second communicator, an e-mail address of a recipient according to a SMTP protocol (See below for specific column/line citations). While Beer does teach that a user enters e-mail address, which is then converted to a URL, Tada also teaches of receiving an e-mail address transmitted from a front end such as a program (col. 1, lines 45-55). Therefore, in

Art Unit: 2154

combining Tada and Beer, it is the email address transmitted from the front end, i.e. email address from Tada's teachings, that is converted to a URL.

7. (3) Applicants submit that none of the documents applied in the rejection disclose, or suggest a controller than transmits, to the recipient via the first communicator, the converted HTML data, based on the URL data, subsequent to the conversion of the received e-mail data into the HTML data. Applicants amend claim 7 to include the limitation of "subsequent to the conversion of the received e-mail data into the HTML data" in order to indicate a lack of an affirmative action by a user.

8. In response, the added limitation of "subsequent to the conversion of the received e-mail into the HTML data" still does not a lack of an affirmative action by a user. In Tada, the email message is converted HTML data prior to sending the converted email message (HTML data), and the user sends a request for the email message (col. 5, lines 18-26). Since the email is converted before sending the converted email (HTML data), the sending of the converted email is subsequent to the conversion to HTML.

9. (4) Applicants submit that URL data is obtained by converting the received e-mail address into the URL data, but that, in the pending claim, the converted URL is not sent as a request.

10. In response, the Examiner recognizes that in the pending claim, the converted URL is not sent as a request. Tada teaches of receiving an email with an email address (col. 4, lines 12-14, 26-27, 39-44), and converting email data with the email into HTML data (col. 4, lines 45-47; col. 5, lines 21-24). Furthermore, converting an email address to a URL is well known in the art as Beer teaches of converting an email address to a URL. It would have been obvious to one of ordinary skill in the art to modify Tada's system with Beer's teachings such that the received email address of Tada is converted to a URL. Tada further teaches that a user using a web browser sends a URL request for the email (col. 3, lines 29-32). It would have been obvious to one of ordinary skill in the art to modify Tada's system for the URL

Art Unit: 2154

request for the email message to match the URL that is converted from the email address, which would result in the transmission of the URL (the URL converted from the email address) and the HTML data associated with the URL (the web page with the HTML data). One of ordinary skill would have been motivated to make such a modification because the modification would provide a specific command from the web browser to obtain the HTML data, and use user-specific information to access data on the web.

11. (5) Beer does not disclose a second communicator which is connected to a receiving Internet facsimile apparatus. Britton, Toyoda, and Beer do not disclose a controller which receives, from the transmitter via the first communicator, URL data according to a HTTP protocol, and converting HTML data into an e-mail address of the receiving Internet facsimile apparatus.

12. In response, Britton has been withdrawn from the instant Office action. However, Examiner respectfully notes that the limitation of “converting HTML data into an e-mail address of the receiving Internet facsimile apparatus” still is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 9 recites the limitations, “convert the URL data into an e-mail address of the receiving Internet facsimile apparatus” and “convert the received HTML data into e-mail data”. Claim 9 does not recite any limitation of a controller that converts HTML data into an e-mail address.

13. (6) Examiner asserts at paragraph 10 of the Office action that features upon which Applicant relies (i.e. controller which converts HTML data into an e-mail address of the receiving Internet facsimile apparatus) are not recited in the rejected claim(s). Applicant submits the Examiner is mistaken. In particular, Applicants submit that the features upon which Applicant relies (a controller which converts HTML data into an e-mail address of the receiving Internet facsimile apparatus) is recited in claim 9 at lines 7-11.

Art Unit: 2154

14. In response, Examiner respectfully disagrees that converting HTML data into an e-mail address is taught. Claim 9 recites the limitations, “convert the URL data into an e-mail address of the receiving Internet facsimile apparatus” and “convert the received HTML data into e-mail data”. Claim 9 does not recite any limitation of a controller that converts HTML data into an e-mail address.

#### **Allowable Subject Matter**

15. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Claim Rejections - 35 USC § 103**

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada, US Patent #6,237,040 (Tada hereinafter), in view of Toyoda et al, US Patent #5,881,233 (Toyota hereinafter), Beer et al, US Patent #5,864,676 (Beer hereinafter).

18. As per claims 7 and 11, Tada teaches substantially the invention as claimed including the method and apparatus for converting and transmitting messages across a network, Tada’s teachings comprising:

a first communicator configured to be connected to a network, the first communicator being a component of the communication control apparatus (col. 5, lines 23-26. Return HTML file to user. First communicator is inherent since the system is able transmit the HTML to the user);

a second communicator configured to be connected to an apparatus, the apparatus transmitting, to a recipient via the communication control apparatus, an e-mail, the second communicator being a component of the communication control apparatus (col. 4, lines 26-27, 39-44. Received e-mail. Second communicator is inherent since the system is able to receive e-mail.); and

a controller configured to:

receive, from the apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol (col. 4, lines 12-14, 26-27, 39-44. Received e-mail. Email addressed to user. col. 1, lines 25-26, 34-35. SMTP.);

receive, from the apparatus via the second communicator, e-mail data directed to the recipient according to the SMTP protocol (col. 4, lines 26-27, 39-44. Received e-mail.);

convert the received e-mail data into HTML data (col. 4, lines 45-47; col. 5, lines 21-24. Convert e-mail data into HTML.); and

transmit to the recipient, via the first communicator, the converted HTML data according to a HTTP protocol subsequent to the conversion of the received e-mail data (col. 5, lines 23-26. Return HTML file to user.).

19. Tada teaches of inputting a URL for WWW service (col. 3, lines 29-32). Tada does not specifically teach of the apparatus being an Internet facsimile apparatus transmitted email to which scanned image data is attached; converting the email address of the recipient into URL data and transmitting the converted HTML data based on the URL data according to a HTTP protocol.

Toyoda teaches of a facsimile apparatus capable of scanning image data and transmitting the image data via electronic mail (col. 29, lines 19-33).

20. It is well known in the art that different types of devices are capable of transmitting and receive electronic mail. It would have been obvious to one of ordinary skill in the art at the time the invention

Art Unit: 2154

was made to modify the system of Tada with the teachings of Toyoda to implement a facsimile apparatus that scans an image and transmits an electronic mail with image data. One of ordinary skill in the art would have been motivated to make such a modification because it increase the field of use of the invention, and allows more than one type of apparatus to transmit email messages.

21. Tada and Beer still do not specifically teach of converting the email address of the recipient into URL data and transmitting the converted HTML data based on the URL data according to a HTTP when the received e-mail data is converted into the HTML data.

Beer teaches of converting an email address into URL data (col. 4, lines 10-30), and using the converted URL to access objects on the network (col. 3, lines 27-31).

22. As previously stated, Tada further teaches that a user using a web browser sends a URL input for the email message. It would have been obvious to one of ordinary skill in the art to modify Tada's system with Beer's teachings such that the received email address of Tada is converted to a URL, and to modify Tada's system for the URL input for the email message to match the URL (the URL converted from the email address), which would result transmission of the URL (the URL converted from the email address) and the HTML data associated with the URL (such as web page with the HTML data). One of ordinary skill would have been motivated to make such a modification because the modification would provide a specific command from the web browser to obtain the HTML data, and use user-specific information to access data on the web.

23. As per claim 8, Tada does not specifically teach the communication control apparatus according to claim 7, wherein the controller converts the e-mail address of the recipient into the URL data by converting an @ mark in the e-mail address of the recipient into a dot and adding HTTP:// at the beginning of the e-mail address of the recipient.



Art Unit: 2154

Tada teaches of converting an email address to an URL, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (col. 4, lines 10-30).

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tada, Toyota, and Beer to convert an email address, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address, which would allow the user to access converted email by URL, and by specifying the process of the conversion from email based protocol to a web based protocol.

25. Claims 9, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McErlean, US Patent #6,883,014 (McErlean hereinafter), in view of Toyoda and Beer.

26. As per claims 9 and 12, McErlean teaches substantially the invention as claimed including the method and apparatus for converting and transmitting messages across a network, McErlean's teachings comprising:

a first communicator configured to be connected to a network (col. 5, lines 16-18, 24-26. Web server receives web-page form. First communicator is inherent since the server is able to receive web-page form from the web.);

a second communicator configured to be connected to a receiving apparatus, the receiving apparatus receiving, from a transmitter via the communication control apparatus, an e-mail (col. 5, lines 20-22. E-mail sent to e-mail receiver. Second communicator is inherent since the server is able to send e-mail to the receiver.); and

a controller configured to:

Art Unit: 2154

receive, from the transmitter via the first communicator, URL data according to a HTTP protocol (fig. 1; col. 5, lines 16-18, 24-26. Server receives web-page form via HTTP. URL is inherent in a web-page.);

receive, from the transmitter via the first communicator, HTML data according to the HTTP protocol (fig. 1; col. 5, lines 16-26. Server receives web-page form via HTTP. Web-page form contains content. HTML is inherent in web page.);

convert the received HTML data into e-mail data (col. 5, lines 20-22. Convert web page form content into an e-mail.); and

transmit to the receiving apparatus, via the second communicator, the converted e-mail data, based on the e-mail address according to a SMTP protocol when the received HTML data is converted into the e-mail data (col. 5, lines 20-22. E-mail sent to e-mail receiver using HTTP).

27. McErlean does not specifically teach that the device is a facsimile apparatus; receiving an email to which the image data is attached and printing the image data to the received e-mail; and converting the received URL data into an e-mail address of the receiving Internet facsimile apparatus.

Toyoda teaches of a facsimile apparatus that receives an electronic mail with image data and printing the image data (col. 29, lines 19-25; col. 32, lines 56-67).

28. It is well known in the art that different types of devices are capable of transmitting and receive electronic mail. And therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of McErlean with the teachings of Toyota to implement a facsimile apparatus that receives electronic mail with image data and print the image data. One of ordinary skill would have been motivated to make such a modification because it would increase the field of use of the invention by allowing different types of apparatus to receive converted email data.

Art Unit: 2154

29. McErlean and Toyoda still not specifically teach of converting the received URL data into an e-mail address.

Beer teaches the relationship between an email address and an URL, and converting from an email address to a URL (col. 4, lines 10-30).

30. Even though Beer does not specifically teach of converting URL data to an e-mail address, Beer teaches of converting an email address to a URL. It would have been obvious to one of ordinary skill in the art to use Beer's teachings to create a method of converting an URL into an email address by merely reversing Beer's process. It would have been obvious to one of ordinary skill in the art to reverse Beer's process and modify the system of McErlean and Toyoda with the suggested teachings of Beer to convert a URL of the web-page form to an email address. One of ordinary skill in the art would have been motivated to make such a modification because it would provide a destination identifier that can be used to send the email via SMTP.

31. As per claim 10, McErlean does not specifically teach the communication control apparatus according to claim 9, wherein the controller converts the URL data to the e-mail address of the receiving Internet facsimile apparatus by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark.

Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).

32. Even though Beer does not specifically teach of converting URL data to an e-mail address by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark, Beer does teach of converting an email address to an URL by adding HTTP:// to the email address and

Art Unit: 2154

converting the "@" into a dot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Beer's teachings to create a method to convert URL into an email address by merely reversing Beer's process. Converting an URL into an email address by deleting HTTP:// in the URL and converting the dot into an "@" would enhance the system of McErlean, Toyoda, and Beer by specifying a process of conversion to allow the email data to be transmitted through the SMTP, and the conversion would allow apparatuses with SMTP based applications to receive the email.

### **Conclusion**

33. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/034,372

Page 12

Art Unit: 2154

April 18, 2007  
JJ

NATHAN FLYNN  
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to be 'Nathan Flynn', written over the printed name and title.